

REMARKS

In the Office Action, claims 38-48 and 54-69 were rejected, and the specification was objected to. The specification has been amended in accordance with the Examiner's comments. Additionally, independent claims 38, 54 and 62 have been amended, claim 40 has been canceled without prejudice, and claims 38-39, 41-48 and 54-69 remain pending in the present application.

Claims 38, 40, 41, 42, 54, 56, 57, 59, 60, 62 and 64 were rejected under 35 USC 102(b) as anticipated by the Mashaw, Jr. et al. reference, US Patent No.: 5,211,241. The rejected independent claims have been amended to clarify aspects of the present invention, and the rejection is believed inapplicable.

The Mashaw Jr. et al. reference describes a sliding sleeve valve using a flow conduit to control and vary flow openings for flow through the valve. A variable flow sliding sleeve valve 10 includes an upper housing 11, a lower housing 12 and a solid walled valve sleeve 13 slidably mounted in the housings with an upper seal 14 and a lower seal 15. A number of internal grooves 20 are circumferentially cut in the lower housing and separated by seal bores 22 which are engageable by lower sleeve seal 15. To sequentially close sections of the sliding sleeve valve, lower seal 15 must be moved across these circumferentially cut grooves 20 of outlying housing 12 for engagement with a subsequent seal bore 22. (See col. 3, line 51, through col. 4, line 8).

The Mashaw Jr. et al. reference fails to disclose or suggest various features of the pending claims. For example, the reference does not disclose or suggest a valve assembly having a sleeve formed by a tubular wall having a plurality of "fluid inlet orifices in the form of holes extending transversely through the tubular wall" combined with a drive mechanism able to move the sleeve to a plurality of flow positions without having the sliding seal "overlap" any of the plurality of fluid inlet orifices, as recited in amended claim 38. By utilizing holes formed transversely through the movable sleeve, there is no need to force the seal across a circumferential gap, as in the cited reference. The Mashaw Jr. et al. reference similarly fails to disclose or suggest a valve assembly having a first member with a plurality of orifices "formed

as holes extending through a wall of the first member" combined with a second member positionable relative to the orifices, and a sliding seal positioned between the first member and the second member, as recited in amended claim 54. The reference also fails to teach these unique features in combination with a drive mechanism able to cause relative movement between the first and second members such that the sliding seal is prevented from overlapping any of the orifices at the multiple flow positions, as further recited in amended claim 54. Again, the cited reference does not disclose or suggest a downhole completion with a valve assembly having a pair of sliding members and a seal disposed therebetween in which at least one of the pair has a plurality of orifices "in the form of holes oriented laterally to enable fluid flow" wherein the seal does not overlap any of the orifices at the selected flow positions, as recited in amended claim 62.

Claims 41, 42, 56, 57, 59, 60 and 64 are dependent claims that ultimately depend from one of the independent claims discussed above. Accordingly, those claims are patentable over the cited reference for the reasons provided with respect to the independent claims from which they depend as well as for the unique subject matter recited in each of those dependent claims.

Claims 38, 40, 43, 44, 54, 55, 56, 59, 60, 62 and 66 were rejected under 35 USC 102(b) as anticipated by the Hines et al. reference, US Patent No.: 4,842,074. The rejected independent claims have been amended to clarify aspects of the present invention, and the rejection is believed inapplicable.

The Hines et al. reference describes a valve for controlling injection into and production from a gas storage well. According to the description, a safety valve 50 includes a sleeve type valve closure means 51 movable between two positions, a closed position and an open position. Piston means 52 and a spring 53 are used to shift valve closure means 51 between the closed and the open positions.

The cited reference fails to disclose or suggest numerous elements of the currently pending claims. For example, the reference does not disclose or suggest a sleeve movable to a plurality of positions including "a closed position, an open position and a plurality of

intermediate positions" as recited in amended claim 38. Similarly, the reference does not disclose or suggest a first member and a second member movable relative to one another to create a "no flow position and a plurality of flow positions" by exposing selected orifices to fluid flow, as recited in amended claim 54. Again, the reference fails to disclose or suggest a pair of sliding members that may be moved to selected positions that "enable a plurality of positive fluid flow positions via flow through different numbers of orifices" as recited in amended claim 62.

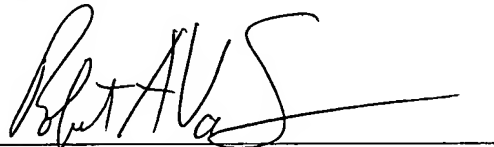
Claims 43, 44, 55, 56, 59, 60 and 66 are dependent claims that ultimately depend from one of the independent claims 38, 54 or 62. Accordingly, the dependent claims are patentable over the cited reference for the reasons provided with respect to the independent claims from which they depend as well as for the unique subject matter recited in each of those dependent claims.

Claims 43 and 66-69 were rejected under 35 USC 103(a) as unpatentable over the Mashaw Jr. et al. reference in view of the Carmody et al. reference, US Patent No.: 5,906,238. Claim 58 was rejected under 35 USC 103(a) as unpatentable over the Mashaw Jr. et al. reference or the Hines et al. reference in view of the French reference, WO 99/19602. Claim 55 was rejected under 35 USC 103(a) as unpatentable over the Mashaw Jr. et al. reference. Claims 39, 45-48, 61, 63 and 65 were rejected under 35 USC 103(a) as unpatentable over the Hines et al. reference in view of the Upchurch reference, US Patent No.: 4,403,659, or the Witten reference, US Patent No.: 4,782,896. Claims 67-69 were rejected under 35 USC 103(a) as unpatentable over the Hines et al. reference in view of the Carmody et al. reference. Each of these rejections is respectfully traversed. However, it is believed unnecessary to discuss in detail the reasons for traversal, because the rejections are believed rendered moot in light of the amendments to the independent claims. Each of the rejections based on 35 USC 103 is provided with respect to dependent claims, and each of those dependent claims ultimately depends from one of the independent claims, 38, 54 or 62, discussed above. The dependent claims are patentable over the cited references for the reasons provided with respect to the independent claims, as well as for the unique subject matter set forth in each of those dependent claims. The secondary references provided in at least some of the section 103 rejections do not obviate the deficiencies of

disclosure in the primary Mashaw Jr. et al. or Hines et al. references discussed above.
Accordingly, all pending claims are patentable over the cited references.

The pending claims are believed to be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert A. Van Someren', written over a horizontal line.

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